

No. 15884

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

ROHR AIRCRAFT CORPORATION and THE FRANKLIN C.
WOLFE COMPANY, INC.,

Appellants,

vs.

RUBBER TECK, INC., RUBBER TECK SALES AND SERVICE CO.,
PAUL A. KARRES, OTTO R. GRASS and JOE P. KERLEY,

Appellees.

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WOLFE COMPANY, INC.,

Appellees.

REPLY BRIEF OF APPELLEES, RUBBER TECK, INC., et al.

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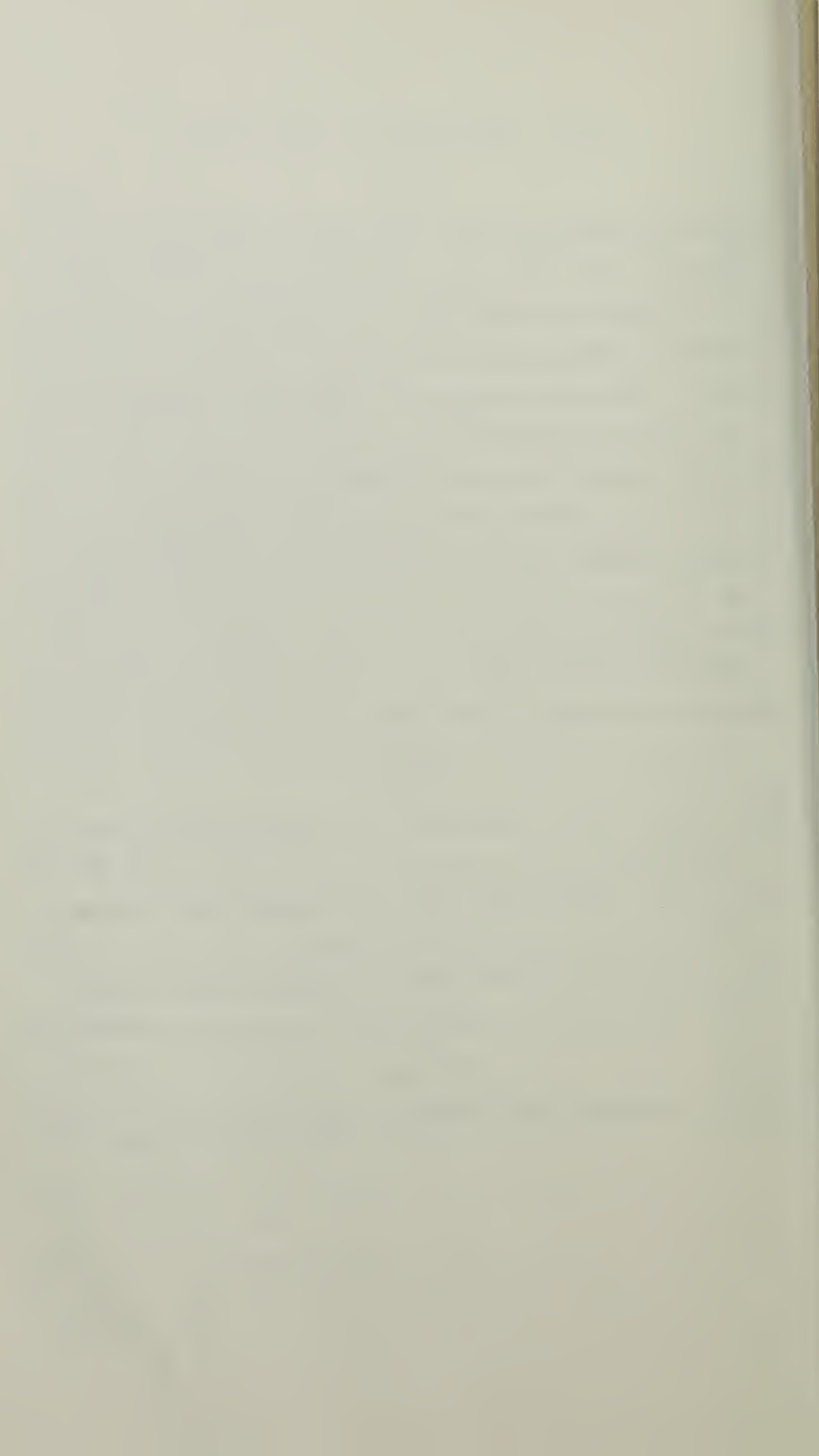
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REPLY BRIEF OF APPELLEES, RUBBER TECK, INC., et al.

Introduction.

The complaint in this case charges the defendants with patent infringement and unfair competition. The lower court rendered a memorandum opinion [R. 31] in which it was concluded

(1) That the defendants did not infringe claim 1 of the patent in suit which is the only claim in issue [R. 33];

(2) That the claim was invalid for lack of invention [R. 35]; and

(3) That there was no unfair competition [R. 36].

Appropriate findings of fact and conclusions of law and judgment were entered accordingly [R. 37-48].

This Court has repeatedly held that questions of infringement, of invention, and of unfair competition are questions of fact and findings thereon will not be treated lightly or overturned unless clearly erroneous. (*Stauffer v. Slenderella Systems of California, Inc.*, 254 F. 2d 127, 115 U. S. P. Q. 347, and cases therein cited.)

The primary consideration on this appeal therefore is whether or not the findings on the question of infringement, invention and unfair competition are clearly erroneous.

Sinclair & Carroll Co., Inc. v. Interchemical Corp., 325 U. S. 327, 89 L. Ed. 1644, indicates that validity of a patent is usually of primary consideration because of the public interest involved, and for this reason, in presenting this brief the defendants have elected to consider and discuss the question of invention in relation to the prior art before discussing the question of infringement.

Claim 1 of the Patent in Suit Is Invalid.

Claim 1 of the patent in suit, which is the only claim in issue, reads as follows:

“1. Means for sealing the walls of a tank secured between the head and shank of a fastener, comprising, in combination, a washer of rigid material having a central bore, surrounding the shank of the fastener and adapted to make rigid contact with the head of the fastener and a tank wall, and a rubber-like doughnut shaped ring positioned within the bore of the washer, said ring having a diameter greater than the thickness of said washer and being confined in said washer with opposite sides thereof normally protruding from the opposite faces of the

washer, whereby upon the underside of the head of the fastener compressing the rubber-like ring against a portion of one contiguous wall of the tank being fastened together, said ring is deformed into sealing contact with the bore of the washer, the shank, the head of the fastener, and said contiguous portion of said wall.”

The object of the patent is to provide a seal against fluid leakage around a bolt, rivet or similar fastener beneath its head.

“Our head seal consists of a metal flat washer, and doughnut shaped rubber-like washer which fits inside of the metal washer. This assembly is placed under the head of the screw, bolt, or rivet prior to installation and the screw or bolt is tightened until a firm metal bearing is obtained between the head, the metal washer and its faying surface. During the tightening, the doughnut shaped rubber-like washer assumes the shape of the rectangular channel inside of the metal washer between the head and the surface to which the washer has been attached.”
[Patent in suit, R. 855, p. 1, column 2, lines 27-39.]

The reason why the “doughnut shaped” rubber washer is caused to “assume the shape of the rectangular channel” is that the rubber washer or O-ring 20 initially fits “closely within the metal collar 21” and is “thicker and extending appreciably beyond the same.” [Patent in suit, p. 2, column 1, lines 64-67.]

The primary reason why bolts, rivets, screws, and the like must be sealed at all against leakage is that these devices are not ordinarily precision devices and are consequently not precisely made. Bolts of a certain nominal size must approach that size reasonably closely—but only within certain manufacturing tolerances. As manufac-

tured today, bolts of a specified nominal size will vary therefrom considerably, some being over-size one or more thousandths of an inch, and others being under-size. If bolts, rivets, and similar fasteners were made precisely to exact size, the holes to receive them could be drilled precisely to the same size and the exactness of fit would make sealing unnecessary as is demonstrated by any metal to metal contact joint that has its parts finely ground to exact size. It is the variation of bolt, rivets, and the like from exact size and the variation of the bolt holes from true nominal size that makes sealing not only desirable, but necessary in structures designed to hold fluids.

In this case the solution of the problem was a simple one. Soft rubber gaskets, washers, and the like had been used for years as seals and were as common as the rubber washers used in couplings of garden hoses. Leo W. Cornwall, one of the joint patentees of the patent in suit, testified by way of discovery deposition as follows [R. 790]:

“I was working under Mr. Gross in the laboratory on the machine and tool designing for the laboratory and, when I came back, several of the other fellows were around one of the displays and Mr. Gross called me over and explained what they were constructing. It seems that the access doors that they had on the airplanes had about 120 bolts on them and, when they built the plane originally, they didn't have any trouble with the leaks but, if they had to get into that door and check all of those bolts out, invariably one or more of them would leak. So they tried to stop it by taking a rubber doughnut with a flat washer over it and put that between the body of the plane and the nut. That was all right as long as the doughnut didn't squeeze out to one side. So Mr. Gross says, ‘Leo, what do you make of this?’ I

took one look at it and I says, 'All you have to do is to put a metal ring around it.' And from there on I did all of the devising of these drawings. I think you will find that there from the original I made for Mr. Gross, and Mr. Gross and I got our names on the patent."

[R. 792]:

"Q. Are all of these designs that I see on the drawings of the patent all yours or are they part Mr. Gross' or are they all Mr. Gross'? A. Do you mean the ideas?

Mr. Miller: Would you repeat the question?

(Question read by the reporter.)

A. Well, I will have to answer that in this way. I had the original idea of putting the washer around the doughnut but the result of this was in cooperation with some suggestions that Mr. Gross had.

Q. What suggestions are there of Mr. Gross, here? A. Well, that will be kind of hard to figure out here because I can't remember details back that far. The best that I could tell you of that, and this is partially guesswork, is I believe that this hood over this doughnut is Mr. Gross'.

Q. You refer to a hood. Is that hood No. 28 on the drawing? A. Yes. I think he will corroborate that. This simple arrangement here—

Q. Pointing to Figure 2? A. Yes, and in Figure 3—this simple arrangement was mine.

Q. That was yours alone? A. Yes. The idea of putting the metal ring around the doughnut was mine."

[R. 793]:

"The only thing I made a hundred per cent and take credit for is the original idea.

Q. When you said the original idea you pointed to Figure 2? A. Yes.

Q. Is that what you consider the original idea, Figure 2 and Figure 3? A. Yes; that is right.”
[See also redirect examination at R. 817.]

But neither Gross nor Cornwall were the first to produce a structure consisting of an outer metal washer or retainer and an inner rubber washer which was initially thicker than the outer metal washer or retainer and which was deformed on tightening two opposed parts. At least four prior patents and publications disclose such a structure, none of which were cited by the Examiner in the United States Patent Office who passed upon the Gross and Cornwall application [see Ex. C], the file wrapper and contents of the Gross and Cornwall application transmitted as a physical exhibit. The references making such a disclosure are as follows:

British patent to Aircraft Components Limited,
and Frederick Edward Killner, No. 537,654
[R. 950];

United States Patent to Seligman No. 2,191,044
[R. 945];

United States Patent to Hart No. 67,539 [R. 927];

United States Patent to Hart No. 128,391 [R. 929].

Claim 1 Is Anticipated by the British Patent to Killner et al.

In the British patent to Killner et al. [R. 950] the patentee was confronted with the same problem of “sealing of a union or conduit connection.” The problem was solved in the same way by placing “a rectangular section ring 7 of synthetic rubber fitting within a steel confining

ring 8 which is axially shorter than the synthetic rubber ring” [see Killner’s complete specification, p. 2, column 2, lines 91-95]. As stated on page 3, lines 9-23:

“It will be seen by comparison between Figures 5 and 6 how, due to the ring 7 being substantially incompressible, the application of axial pressure results in reducing the overall length which must obviously be taken up by radial expansion. Due to the presence of the confining ring 8, the radial expansion can in this case occur inwardly only, and that against the pressure of entrapped air and any tendency to leakage from the interior of the connection into the space 17 (Figure 3).

“The axial length of the confining ring may be so chosen as to ensure that when the assembly is tightened up adequately, the confining ring is gripped between the parts 9 and 10 so that the deformable ring 7 is completely relieved of any structural loads to be transmitted between the parts 9 and 10.

“In practice it is found that it is necessary to screw the nuts up only finger tight to provide an effective seal against high internal pressure.”

See also, page 2, column 1, lines 23 *et seq.*:

“Although the deformation may bring the inner periphery of the deformable member *directly into sealing engagement with a cooperating surface of an assembled connection*, it is preferable that the inner surface of the washer shall be spaced from the cooperating wall of the connection so that pressure fluid can find its way into the space and so apply pressure tending to increase the sealing action of the washer.”

It is the defendants’ contention that claim 1 of the Gross and Cornwall patent in suit was completely an-

ticipated by the British patent to Killner *et al.* The problem was the same, namely, to prevent leakage around a generally cylindrical fastening element. The solution was the same, *i.e.*, produce an outer metallic washer or confining ring and place within it a rubber ring that is axially thicker than the washer or confining ring so that on tightening, the rubber will be squashed or deformed into sealing engagement with the surfaces that must be sealed against leakage. Surfaces that must be sealed against leakage as pointed out in the Killner specification are the surfaces at the top and bottom of the rubber ring. Whether the rubber actually engages the shank and seals against the shank is optional and is of no great consequence. If there is a small space within the inner periphery of the rubber ring "pressure fluid can find its way into the space and so apply pressure tending to increase the sealing action of the washer."

The only pictorial difference between the drawing of the patent in suit and that of Killner is that the rubber ring 20 in the patent in suit is initially round in cross-section, whereas in the British patent to Killner *et al.* it is initially rectangular. This however, makes no material difference as both are deformed when under compression into rectangular cross-sections *of the same shape*. Compare the shape of Killner's compressed rubber ring 7 in Fig. 6 with the shape of Gross and Cornwall's compressed rubber ring in Fig. 3 of the patent in suit. Therefore it makes little difference whether the initial shape of the rubber is round in cross-section as in the patent in suit, or whether it is merely taller than it is wide as in Fig. 5 of the Killner *et al.* patent.

Attention should be called to the claims of the Killner patent. Neither claim 1 nor claim 2 define the deformable

ring as being rectangular in cross-section. But claim 3 reads:

“A sealing washer as set forth in either of the preceding claims, in which the deformable member is a ring *rectangular in cross-section.*”

By comparison and contrast of claim 3 with claims 1 and 2 it is obvious that Killner contemplated using rubber rings of other cross-sectional shapes than rectangular and intended that claims 1 and 2 cover such shapes even though claim 3 might be restricted or limited to only a rectangular shape.

The Gross and Cornwall patent in suit differs from the Killner patent in merely having the four corners of the Killner rubber ring rounded off. The Seligman patent, hereinafter discussed, teaches that the inner corners can be rounded off. It is not invention to round off corners of Killner's rubber ring. See *Oxford Varnish Corporation v. General Motors Corporation*, 23 Fed. Supp. 562, 38 U. S. P. Q. 42, 49:

“That is the reason we put stairs in a house, so we do not have to jump clear upstairs at one step. *We round off the edge of the steps so we will not stub our toes and hurt our feet.* One of the old reasons why we *round things* off is to give protection. I am not going to bother to find a way of saying defendant's machines did not infringe because there is nothing in front of defendant's work. In defendant's tray, the protecting portion does not come up in front of the work, but the *rounding off* he does extends down far enough so that they use this rounding feature. It is such a worthless claim that I would rather kill it than say it was not infringed. I hold it void as lacking in anything but the simplest mechanical

expediency. *It would not require a skilled mechanic to think of rounding off the sharp corners, but such a 'dumb' mechanic.*" (Emphasis added.)

See also, *Acton Mfg. Co., Inc. v. Louisville Tin & Stove Co.*, 116 Fed. Supp. 796, 99 U. S. P. Q. 410, 412:

"The real question, therefore, is whether or not the plaintiffs' Cooler was of such novel design as to show creative or inventive genius. I do not think it was. The plaintiff's box shows novelty in general appearance with its *rounded* corners, conforming, as one of the witnesses pointed out, to the general modern trend of many articles of metal exterior. *This is in contrast to the former sharp edges and square angles.* The best examples of such designing is the present models of automobiles. Added to this is the modern tendency for bright color and the general arrangement which appeals to the aesthetic sense and is pleasing to the eye of the ordinary observer as new and novel.

"Such improved features, however, are no more than the natural development and progressive change in appearance of a long established prior art.

"Every improvement, either in utility or design, even to the extent of radical changes in appearance and function, is not such evidence of inventive genius that the most recent workman can claim a monopoly of production under the patent laws."

The foregoing case was cited with approval in *Cornick, doing business as Piece Control Tag Company v. Stry-Lenkoff Company et al.*, 134 Fed. Supp. 125, 107 U. S. P. Q. 207, 211:

"In the *Acton Manufacturing Co. v. Louisville Tin & Stove Company* case, 116 F. Supp. 796, 798, 99 USPQ 410, 412, Judge Swinford, a Judge of this

Court, considered the validity of a design patent, D-152580, which was for a portable beverage cooler. In that, as well as the case at bar, the patent had been granted upon the idea that the *rounded corners* of the device merited the award of the patent. The alleged infringement, if the validity of the patent was sustained, was admitted. But Judge Swinford held the patent invalid, holding that the rounded corners on the cooler were no more than the natural development and progressive change in appearance of a long established prior art, and said * * *.”

The converse of the proposition that no invention is involved in rounding square corners is equally true. It is not invention to give a straight face to a curved surface. See *Frederick Edward Hoddersen-Balling v. Daniel F. Lorenz*, 15 U. S. P. Q. 35, 37. Also, *Shenfield v. The Nashawannuck Manufacturing Company et al.*, 137 U. S. 56, one of the cases referred to by Mr. Justice Douglas in his concurring opinion in *Great Atlantic & Pacific Tea Company v. Supermarket Equipment Co.*, 340 U. S. 147. In the *Shenfield* case the Supreme Court said:

“We agree with the learned judge holding the circuit court, that it did not involve invention—‘to make a suspender-end of flat cord in substantially the same way that suspender ends of round cord had been made * * *.’”

No United States patent was ever obtained in the United States corresponding to the British patent to Killner. Consequently, the Killner invention is public property in the United States and is in the public domain. The plaintiffs in this case would attempt to deprive the public of a fair use of the Killner invention by asserting that the public can make the Killner seal only so long as the initial shape

of the rubber is rectangular as shown in the Killner patent, but that the public, including these defendants, cannot make or sell the Killner seal if the rubber is of round cross-sectional shape.

We believe that the statements made by the Supreme Court in *Atlantic Works v. Brady*, 107 U. S. 192, 200, are applicable:

“The process of development in manufacture creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. *To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences.* The design of the patent laws is to reward those who make some substantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. *It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures.* Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. *It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country*

without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.” (Emphasis added.)

Here, the plaintiffs are urging that it was invention to make the inner rubber ring 7 of the Killner patent of round rubber in the same place, in the same environment, and for the same purpose that Killner’s rectangular rubber ring had been made. In support of this contention plaintiffs admit at page 22 of their opening brief:

“It is, of course, true in the present case that the washer serves its respective function as a bearing member, and the O-ring serves its respective function as a seal, but (plaintiffs allege) together they produce new and additional results.”

These results are alleged to be (Pltf. Op. Br. p. 22):

“(1) The ring serves to center the assembly on the shank of the bolt thus providing an annular channel of uniform width into which the ring may be deformed.

(2) The ring is deformed gradually from a round to a rectangular shape and the washer limits this deformation to prevent extrusion.”

These alleged new and additional results simply do not exist.

At the outset, we should call attention to the fact that nowhere in the patent in suit is there any mention of the self-centering ability of the patented seal. While Gross testifies to this quality as quoted on page 18 of plaintiffs’ brief, the point was not argued and not stressed by the

plaintiffs in the court below. Furthermore, self-centering in a horizontal direction could only occur if the bolt, O-ring, and washer were precisely made in relation to each other. As above pointed out, bolt shanks are not precisely made; they are only made within manufacturing tolerances. O-rings also are manufactured only within tolerances. Defendants' witness Otto Grass testified at R. 717, that the most popular sizes for the sealing devices of the character of the accused "Duo-Seals" and plaintiffs' "Lock O Seals" were one-quarter, three-sixteenths, and five-sixteenths of an inch. Taking the one-quarter inch size as being typical and referring to Plaintiffs' Exhibit 39 at R. 869, the inside diameter is shown as having a plus or minus tolerance of .005" and the cross-sectional diameter is shown as having a plus or minus dimension of .003". Even the metal retainer ring is shown as having an inside dimension A with a tolerance of a plus or minus two-thousandths and an outside dimension with a tolerance of plus or minus four-thousandths. Similar tolerances are shown on Plaintiffs' Exhibit 1, appearing at R. 827. These tolerances may at first glance appear to be small but considering the fact that the seal is to be applied to a $\frac{1}{4}$ " bolt it should be apparent that within the tolerance of the bolt shank, the inside diameter of the rubber O-ring, and the inside diameter of the retainer there is plenty of opportunity for looseness of the rubber O-ring in relation to the bolt shank or looseness of the rubber O-ring in relation to the interior of the washer. Either looseness would militate against the self-centering now claimed to be virtue of the plaintiffs' seal.

But regardless of whether self-centering of the seal with relation to the bolt shank takes place or not, it is of no great consequence. The plaintiffs' argument proceeds on the theory that all deformation of the rubber must take

place radially with respect to the axis of the bolt shank and that if the space within the metal washer is non-uniform around the bolt shank, that extrusion of the rubber will necessarily follow. However, rubber in the O-ring can deform in a circumferential direction as well as in a radial direction. Therefore, even if the space between the wall of the bore of the washer is narrower on one side of the bolt shank than on the other because the seal is not perfectly centered, the rubber can be deformed circumferentially as well as radially around the bolt shank to that portion of the annular channel having the greatest volume.

There is another reason, however, why plaintiffs' contention is unsound. Even if there were a slight off-centering of Killner's seal with respect to his bolt, it does not follow that his seal would invariably act as depicted in the illustrations opposite page 26 of Plaintiffs' Brief. On the contrary, as the rubber starts being compressed by the tightening of the bolt or fastener, before the rubber will extrude over the top and bottom of the retainer ring, as depicted in Fig. 3 (opposite p. 26 of Pltf. Br.) great pressure must be exerted by the rubber that is on the left-hand side of this figure against the internal wall of the retainer ring. This pressure would naturally urge the retainer ring from right to left as depicted in this figure. This pressure exerted by the compressing rubber against the interior of the retainer ring on the left-hand side of this figure is unopposed by any corresponding pressure on the right-hand side of the retainer ring due to the fact that the rubber on the right-hand side is spaced from the shank of the fastener and can freely expand into that space. Under these circumstances and conditions, the only thing that will resist movement of Killner's seal from an off-center position into a self-centering position would be

the friction between the rubber, the head of the fastener, and the wall. If this friction is sufficient to hold the seal in place, then the seal will be tightened in an off-center position. *But if the friction between the rubber, the head of the fastener and the wall is insufficient to resist the tremendous pressure exerted by the rubber compressing into an abnormally small space, then the seal will be automatically moved into a more centered position.* This is probably what occurred in the actual courtroom demonstration [712, 713] made with an exemplar of the Killner seal hereinafter referred to.

The plaintiffs' contention that a round rubber O-ring serves to center the assembly on the shank of the bolt whereas Killner's rectangular ring would not, is therefore without merit.

The second contention made by the plaintiffs is that the ring is deformed gradually from a round to a rectangular shape and the washer limits this deformation to prevent extrusion. In a similar manner Killner's ring 7 is gradually deformed from its higher than wide condition, shown in Fig. 5, to its wider than high condition depicted in Fig. 6. Defendants' witness Grass at pages 709 to 715 put on demonstrations in the courtroom before the Court using:

- (1) a "Lock-O-Seal" of plaintiffs' manufacture;
- (2) a seal made in accordance with the disclosure of the Killner patent; and
- (3) one of the accused "Duoseals"

and concluded that all extruded very slightly and to about the same extent. As between the testimony of plaintiffs' witness Gross and the court demonstration made by Grass, the court must have elected to accept and believe the Grass

demonstration and accordingly made Finding 14 [R. 40] reading in part as follows:

“Plaintiffs contend that when pressure is applied a ‘doughnut shaped’ ring will be distorted or deformed so that it will fill the voids between the bore of the washer, the shank, the head of the fastener and the wall, and that there is something about a ‘doughnut shaped’ ring that makes it more adaptable to being deformed than rings of other shapes. However, when pressure is applied a rubber ring within a surrounding thinner metal washer has to be deformed regardless of the shape it is in at the time the pressure is brought to bear.”

This finding is amply supported by concrete evidence put on before the court in actual courtroom demonstration with the plaintiffs’ Lock-O-Seal, an exemplar of the Killner seal, and the defendants’ accused “Duoseal.”

Furthermore, plaintiffs’ expert, Comstock testified [R. 147]:

“Well, any ring or any kind of seal would be deformed under pressure, wouldn’t it? Suppose you put an aluminum ring in instead of a rubber, and you bolted this down and put on pressure. There is a tendency to deform the ring, isn’t there, regardless of the material?”

The Witness: That’s right, * * *.”

The Seligman Patent [R. 945] Is Another Anticipation.

In the Seligman patent [R. 945] the problem was identically the same and the solution was the same. In the Seligman patent the problem was to prevent leakage between adjacent plates of a heat exchanger. In Fig. 8, the plates 10 and 20 are shown as being flat plates, but in Figs. 9 and 10 the plates 10 and 20 have depressed center

portions corresponding to the shanks of the bolts or rivets of the patent in suit. These depressed center portions are within outer flat margins which correspond to the head and wall, respectively, of the patent in suit. In the Seligman patent, as well as in the patent in suit the problem is to provide:

“a resilient packing material” [Seligman patent, p. 1, column 1, line 18] which will prevent leakage between the plates.

At page 25 of plaintiffs’ brief, plaintiffs assert:

“In other words, Seligman intended that the plates which are separated by the spacer *would not rest on the metal frame but on the spacer alone* as is clearly seen in Figures 8, 9 and 10 of the Seligman drawings.” (Emphasis added.)

It is true that Figs. 8, 9, and 10 seem to indicate a slight spacing between the margins of the plates and the metal frame 9. However, these figures are not described as showing the plates in their fully tightened or fully compressed condition. Furthermore, as stated in the Seligman specification, page 1, column 2, lines 26 *et seq.*:

“As will be seen from Figs. 8, 9 and 10, which figures show a frame member incorporating the invention arranged in position between the marginal edges of a pair of heat exchange plates 10 and 20, *the portion 9 of the frame* serving to restrain the packing material against outward movement *may also be utilized to limit the extent to which the plates may be caused to move towards each other* when the stack is under compression.” (Emphasis added.)

There is thus a clear disclosure in the patent of utilizing the surrounding metal retainer or frame not only to prevent outward spreading of the rubber but also to limit

the extent to which the opposed surfaces can be brought together in compressing the rubber.

The shape of the seal shown in cross-section in Figs. 6 and 7 of Seligman should be compared carefully with the shape of the defendants' accused "Duo-Seals," one of which is illustrated in enlarged section at the bottom of page 996 of the record. In both constructions there is an outer metallic or incompressible retaining ring which prevents outward spreading of the rubber when the rubber is compressed. In both instances the rubber is initially thicker vertically than the retaining ring. In both instances, the rubber has a rounded top and bottom and a rounded interior. In both instances, the outer side of the rubber extends from top to bottom of the inner wall of the retaining ring as distinguished from being tangent thereto as in the patent in suit, and in plaintiffs' "Lock O Seals." In both instances, the rubber is vulcanized to or bonded to the retaining ring so that it cannot become separated therefrom. Seligman describes Figs. 6 and 7 as follows, page 2, column 1, lines 16 *et seq.*:

"Alternatively, the frame may be formed so that it is composed in part of a hard or non-compressible material and in part of a resilient or compressible material. For instances, as is indicated in Figs. 6 and 7, the outer edge portion of the frame may be constituted by a strip 15 of metal or other hard material (*e.g.* hard rubber) and the inner edge portion of the frame may be constituted by strip 16 of compressible material such as soft rubber which is *vulcanized on* or otherwise attached to the strip 15." (Emphasis added.)

Briefly stated, the defendants' accused "Duo-Seals" are virtually identical in construction with the seal disclosed in the Seligman patent, the only difference being that Selig-

man's seal is rectangular in plan to fit rectangular heat exchange plates, whereas defendants' accused "Duo-Seals" are circular in plan. Even the self-centering features and the gradual deforming of the rubber from a round to a rectangular shape now stressed by the plaintiffs, are present in Seligman's seal to the same extent as they are present in the defendants' accused "Duo-Seals."

With respect to the difference in shape in plan plaintiffs' expert Comstock testified at R. 165 *et seq.*:

"Q. The reason that these seals are made round in plan, round in configuration when you look down on them, is that they are designed to fit around cylindrical fasteners such as bolts and rivets. A. That's right.

Q. Suppose that the bolt or rivet happened to be oval-shaped in cross section, would you make the metal washer oval-shaped and the rubber O ring oval-shaped? A. *Certainly*, your metal washer would have to be oval-shaped, because you couldn't deform it, assuming that you have a rigid metal washer. It would have to correspond in its contour. The rubber, you could probably take a pure circular one and put it around an oval shank, assuming you had your proportions right. You could do it either way, I should imagine. I haven't ever considered that proposition. I don't know.

Q. You just make the configuration of the rubber ring and the metal ring to conform to the shape of the cross section of the shank of the fastener that you are going to seal. A. You would necessarily, the metal, I think. As I say, you might or might not have to make the rubber ring. You might be able to use a circular rubber on it.

Q. Are you familiar with carriage bolts? A. Is that a bolt which is square in cross section?

Q. Near the head of the bolt, they have a square portion. A. Yes.

Q. You have seen those? A. Yes, I believe so. I have seen those.

Q. Suppose you want to seal a carriage bolt that had that square portion. Would you make the metal ring and the rubber ring square to fit around that?

A. Well, you have got a different problem there. You could probably approach it either way. You could probably approach it with a circular ring and a substantially—that is a circular washer and a substantially circular ring, or you could probably approach it from a square one. I think if you sat down to work it out, you could probably do it either way, but I wouldn't be sure about it."

* * * * *

"Q. The natural thing to do would be to make a square washer, metal washer, and a square rubber ring? A. I think that is probably the first thing you would do if you were trying to make that type of seal.

Q. Would you say that the rubber when it was square configuration is still doughnut-shaped? A. Well, *the doughnut shape, I think, refers more to the sectional configuration of the ring* rather than the overall configuration, because the claim says a rubber-like doughnut-shaped ring.

Presumably the word ring means the circular and the doughnut-shaped would mean more than cross-section.

Of course, this phrase has to be interpreted in the light of the drawings and the disclosures of the patent, but I would say if you had the square in configuration, but you still had it rounded or substantially circular in section, that it would probably come within that term, doughnut-shaped ring.

I think you can have a square ring.

Q. I will show you a copy of the Seligman Patent No. 2,191,044 and ask you whether or not the shape that we have here of the rubber shown in Figures 6 and 7 is doughnut-shaped. A. *Yes, I think that would be.*"

Defendants regard these statements on the part of plaintiffs' expert Comstock to be tantamount to an admission that claim 1 of the patent in suit is anticipated by Seligman. Claim 1 calls for the combination of:

"a washer or rigid material having a central bore, surrounding the shank of the fastener and adapted to make rigid contact with the head of the fastener and a tank wall."

It does not say "a *round* washer" and was apparently never intended to be limited to round washers as distinguished from oval washers or square washers.

In Seligman, the outer frame 9 in Figs. 8, 9, and 10 and the outer frame 15 in Figs. 6 and 7 is of rigid material and has a central bore or opening surrounding the depressed center portion of the plate 10 in Figs. 9 and 10 corresponding to the shank of the fastener. The washer or frame is adapted to make rigid contact with the opposed margins of the plates 10 and 20 when these plates are compressed towards each other, because, as stated in the specification the rigid washer or frame:

"may be utilized to limit the extent to which the plates may be caused to move towards each other when the stack is under compression" [p. 1, column 2 of Seligman's specification, lines 33-35].

Furthermore, under Comstock's admission Seligman's rubber ring 16 is a "doughnut-shaped ring," and it is

within the bore of the washer or frame 15. Also, the ring has a diameter or vertical thickness greater than the thickness of the washer:

“and being confined in said washer with opposite sides thereof normally protruding from the opposite faces of the washer, whereby upon the underside of the head of the fastener (the underside of the margin of plate 10) compressing the rubber-like ring against a portion of one contiguous wall of the tank being fastened together (the margin of the plate 20), said ring is deformed into sealing contact with the bore of the washer, the shank, the head of the fastener, and said contiguous portion of said wall.” Claim 1 of the patent in suit with parenthesis added.

Plaintiffs may argue that in Seligman the rubber ring 16 on being compressed is not “*deformed into sealing contact with the bore of the washer*” because it is already in full and complete contact therewith, being vulcanized thereto or bonded thereto from top to bottom of the frame 15. If so, the same is identically true of the defendants’ accused “Duo-Seals” illustrated at the bottom of page 996 of the record.

The plaintiffs are therefore placed on the horns of a dilemma. Either the term “doughnut-shaped ring” refers to a ring truly circular in cross-section which is initially tangent to the vertical wall of the bore of the washer and “*is deformed into sealing contact with the bore of the washer*” or the term “doughnut-shaped ring” is broad enough to cover a rubber ring of defendants’ cross-sectional shape wherein no deformation against the wall of the bore of the washer is possible. In the latter case the claim is fully anticipated by Seligman.

It would seem to be obvious that if the plates of the heat exchanger of Seligman were round in configuration

or in plan that Seligman would have made his seal to conform thereto in shape, in which case Seligman's seal would be just as much an anticipation as the defendants' accused "Duo-Seals" would be an infringement.

The Anticipatory Effects of the Hart Patents.

Hart Patent No. 67,539 [R. 927] shows in Fig. 5 a washer F having within it a thicker rubber washer E. As stated in the specification:

"It consists in forming a groove, channel, or chamber in the washer commonly used on bolts, or in the washer and nut combined, and filling said channel with an India-rubber or other elastic packing, and so that it (the packing) will not spread laterally outward, or arranging it so that, if desirable, said packing may spread laterally inward and press against the sides of the bolt; and thus afford additional hold, as will be explained."

In the second Hart Patent No. 128,391 [R. 929], a nut lock is disclosed consisting of an outer metal ring or band C within which:

"A represents a gum washer, the outer face of which is convexed * * *."

In both of the Hart patents the rubber ring inside of the surrounding metal ring is thicker than the metal ring so that on tightening the bolt the rubber washer or ring must be deformed. In neither of these patents is the rubber ring truly circular in cross-section, but in neither of them is the rubber washer truly rectangular. While both of these patents pertain to washers which are to function as lock washers to prevent loosening of bolts and nuts, it is obvious that to use them as liquid seals is but a new use of an old and known article.

Generally, it is not invention to use a known article for a new and analogous use. *Walker on Patents, Deller's Edition*, page 228. Furthermore, the very fact that plaintiffs have selected as their trademark "*Lock O Seal*" indicates that use of their seal as a lock washer as well as a seal is now contemplated.

In the course of the prosecution of the plaintiffs' application for a patent before the United States Patent Office, plaintiffs' attorneys interviewed the Examiner and following the interview presented the following argument at pages 18 and 19 of Exhibit C, the file wrapper and contents of the application for the patent in suit:

"As pointed out during the interview no reference of record shows the combination defined by claims 11 and 12 wherein there is a rigid metal to metal contact between the fastening and the walls of the tank to avoid possibility of subsequent looseness. Also, the metal to metal contact provided by the present arrangement makes possible a structural tightness that is not effected by cold flow of resilient sealing material, such as is the case when a rubber washer is used, as shown in the references cited, instead of the rubber doughnut and metal retainer ring of the present invention.

"Further, note that when the metal to metal contact is obtained between the metal retainer ring and the tank walls, the rubber doughnut 20 is thus put under compression and said doughnut then acts as an effective *lock which cooperates to prevent loosening of the screw (nut) on the bolt.*" (Emphasis added.)

When this argument was presented as to the ability of plaintiffs' seal functioning as a lock washer, it certainly became incumbent upon the Examiner to cite the two Hart patents against this aspect of the alleged invention.

Summary Re Prior Art.

This Court in *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 91 U. S. P. Q. 24, 27, said:

“But further, a great many of the patents, which were brought to light in this lawsuit and considered by the Trial Court, had not been previously considered by the Patent Office. *Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated. Such is the case here.*” (Emphasis added.)

Here, there are four prior art references which have not been considered by the Patent Office and which any careful conscientious Examiner would certainly have cited had he been aware of their existence.

In *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, 87 U. S. P. Q. 303, 305, the Supreme Court said in the majority opinion:

“The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or electronics, take on some new quality or function from being brought into concert, *but is not a usual result of uniting elements old in mechanics.*

* * * * *

“Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. *Patents cannot be sustained*

when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, *obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men.*" (Emphasis added.)

Here, washers and rubber O-rings are conceded to be old *per se* (Plft. Op. Br. p. 21). The combination of a metal washer and a thicker rubber ring within it intended to be deformed on tightening a bolt, is also old. The plaintiffs *would prevent* by means of their patent the mere substitution of a rubber O-ring for the rectangular rubber ring of the Killner *et al.* patent whenever a skillful mechanic or skilled artisan happened to have a rubber O-ring available and did not have a rectangular rubber ring but nevertheless wished to make a Killner seal. Although the Killner patent shows his rectangular rubber ring with nicely squared corners, as a practical matter in the normal manufacture of rubber articles such nicely squared corners are not ordinarily obtained. Plaintiffs' expert admits this [R. 174]:

"Q. Then if you start out with a rubber ring that is square in cross section, you are going to have in the normal course of manufacture rounded corners on it."

* * * * *

[R. 175]:

"The Witness: Yes, I think that in ordinary manufacture you would, unless they were particular about achieving exactly square corners. If they wanted to watch it and reject every one that did not have exactly

square corners, then they could certainly turn them out that way.

* * * * *

Q. I show you Figs. 5 and 6 of the British Patent No. 537,654. I call your attention to Figures 5 and 6. In Figure 5, is that ring doughnut-shaped?

A. What do you mean by the ring?

Q. The ring in here is the inside part 7, which is within a retainer 8, and it shows a cross section of it. Is that doughnut-shaped? A. No, that is not doughnut-shaped. It appears to be square in its cross section.

The Court: *It would be doughnut-shaped if you shaved off the corners?*

The Witness: *Yes, if you shaved them off enough so you get a substantially circular effect, then you have got a doughnut shape.*

Q. (By Mr. Miller): If they were made in the normal course of manufacture, they would have rounded corners? A. Oh, I would say in the normal course of manufacture, it would not have sufficiently rounded corners to make it operate like the Gross device, probably. There again, it is speculation.

Q. *How much rounded corners do you have to have in order to get it to work like Gross?* A. Well, that is like saying how high is up. *I don't know just where the dividing line is. * * *."*

Certainly it is a resource available to skilled men to make a seal as disclosed in the Killner *et al.* patent, either with square corners or with rounded corners. To uphold claim 1 of the patent in suit would serve to withdraw into the field of its monopoly all seals whose rubber rings had rounded corners or which more or less closely approached truly circular cross-section.

Likewise, it would withdraw into the field of the monopoly a seal having the structure and cross-sectional configuration of the Seligman patent. The Seligman seal is only rectangular in plan because he was sealing rectangular heat exchange plates. Neither Seligman nor anyone else should be deprived of the right to make the Seligman seal circular in plan instead of rectangular if they have occasion to seal around circular objects. This Court said in *Jacuzzi Bros. v. Berkeley Pump Co., supra*:

“The appellant argues that the literature of the alleged anticipations, such as patents, or publications, must bear adequate directions for construction of the devices sought to be invalidated. *But, where the accused device could be made by a competent mechanic by following suggestions or use of portions of such documents exemplifying prior art, such a doctrine is inapplicable. Cf. Cohn v. United States Corset Co., 93 U. S. 366, 367; Eames v. Andrews, 122 U. S. 40, 66. Otherwise, this supposed rule would negative the use of equivalents.*” (Emphasis added.)

The lock washers shown in the two Hart patents should be freely available to any skilled mechanic to use them as seals as well as lock washers if the bolts about which they are positioned extend through walls of tanks intended to carry fluids. Plaintiffs would restrict this use of the Hart lock washer to bolts that did not have to be sealed.

We submit there is ample evidence to support the Trial Court's Finding 16 [R. 41]:

“There is no invention in the structure defined by claim 1 of the patent in suit * * *.”

There Is No Infringement.

Assuming arguendo that claim 1 of the patent in suit is to be sustained, it is manifest that if it is to be held valid over the previously mentioned prior art that it must be restricted to a circular washer having within it a thicker circular rubber ring which has a cross-sectional shape that is truly circular so that on compression by the fastener:

“said ring is deformed into sealing contact with (1) the bore of the washer, (2) the shank, (3) the head of the fastener, and (4) said contiguous portion of said wall.”

The defendants' accused “Duo-Seals” illustrated at the bottom of R. 996, do not have the rubber ring of truly circular cross-section, the very distinction between the seal of the patent in suit and the seal of Killner *et al.* Instead, the outer side of the rubber ring is in full contact with the bore of the washer from top to bottom and is firmly bonded thereto. Being initially in full contact with the bore of the washer, it is manifest that defendants cannot comply with the term of the claim reciting the “ring is *deformed* into sealing contact *with the bore of the washer.*” Defendants' rubber ring is already in full, firm, bonded contact with the bore of the washer and cannot be deformed into sealing contact therewith.

In *Smith v. Nichols*, 21 Wall. 112, 119, the Supreme Court said:

“. . . a mere carrying forward . . . of the original thought, a *change only in form*, proportions, or degree . . . doing the same thing in the same way, by substantially the same means, with better results, is not such invention as will sustain a patent.”
(Emphasis added.)

The above quoted portion of *Smith v. Nichols* was quoted with approval and applied by this Court in *Wilson-Western Sporting Goods Company v. Barnhart*, 81 F. 2d 108, 28 U. S. P. Q. 125, 128, in a case involving a flexible rubber sealing member—very much the same as here.

In *Winnans v. Denmead*, 15 Howard 330, 343, the Supreme Court said:

“Undoubtedly there may be cases in which the letters patent *do include only the particular form described and claimed*. *Davis v. Palmer*, 2 Brock, 309, seems to have been one of those cases. But they are in entire accordance with what is above stated. The reason why such a patent covers only one geometrical form, is not that the patentee has described and claimed that form only; *it is because that form only is capable of embodying his invention*; and, consequently, if the form is not copied, the invention is not used.” (Emphasis added.)

Here, in seeking to avoid the anticipatory effect of the Killner, Seligman, and Hart patents, plaintiffs contend that their ring is “doughnut-shaped” meaning truly circular in cross-section, and not of any of the anticipating shapes. If the truly cross-sectional shape is the only form capable of embodying their invention to render it patentable over the shapes of the prior art, it follows that the defendants have not copied this form of plaintiffs’ invention and that plaintiffs’ alleged invention has not been used.

The lower court therefore was correct in Finding 13 [R. 40]:

“Plaintiffs used the term ‘rubber-like doughnut shaped ring’ in the patent and this term must be strictly construed as against them.”

The lower court was also correct in Finding 14 [R. 40]:

“The rubber ring used by defendants is not a doughnut shaped ring.”

And, in concluding in Conclusion of Law 3 [R. 45] that there was no infringement as to claim 1.

Claim 1 Is Invalid for Indefiniteness.

No one can tell under plaintiffs' interpretation when his rubber ring is doughnut shaped and when it is not. The matter was succinctly brought out during the trial [R. 1860]:

“The Court: I suppose he did that with the idea that everybody knows what a doughnut-shaped object is. I thought I did before you explained it. *I don't know now whether I do or not.* But he used the word ‘doughnut-shaped.’

The Witness: Yes.

The Court: Would it have been just as well for him to have said, instead of saying doughnut-shaped, *so shaped* that it would be deformed?

The Witness: Well, as I say, it would be just as well except for this technical objection that the examiner would probably raise to our defining a physical element solely in terms of its function and they prefer to have some term in there that is not purely functional, so you put in a word like ‘doughnut-shaped,’ but you interpret that in the light of the remainder of the claim and also in the light of the specifications and drawings, so that looking at it that way, it means that it would have to be rounded off or cut off at its corners in order to get this effect, but as a patent lawyer you would try to avoid that and the examiner would probably criticize you if you worded it in that manner. But that is actually the essence of what the claim means. *Any ring that is so shaped that it will*

perform this in my opinion would be doughnut-shaped. I think it would have to be. If you could figure out some way to make it—I don't see how you could possibly do it without having a ring that is sort of rounded or sheared off at the corners. If there is some other conceivable way to do it, maybe that would avoid infringement, but I can't see how it could be done.

The Court: I asked you that question with a certain thing in mind, because a question came up in my mind when I first read the patent before trying the case of what is meant by doughnut-shaped, and the only way I could figure out was that it was some object shaped in the form of a doughnut.

The Witness: That's right.

The Court: And recognizing the fact that doughnuts are not uniform, at least they were not uniform when they were handmade, but now they have machinemade doughnuts they are more uniform.

The Witness: They aren't as good, though.

The Court: They are probably not as good, but everybody has a definition of the word 'doughnut-shaped.' Doughnut-shaped, in your opinion, is broader than circular cross-section.

The Witness: Yes, I think so.

The Court: But you believe that the words 'so shaped' could be substituted for 'doughnut-shaped.'

The Witness: Apart from the technicalities of patent law, yes, looking at it from an interpretation point of view, yes.

The Court: I wonder if any other counsel here have read the Parker case."

The *Parker* case referred to by the Court was *Parker Appliance Co. v. Masters*, 94 Fed. Supp. 72, 87 U. S. P. Q. 86, affirmed on opinion below, 92 U. S. P. Q. 247.

We believe that the *Parker* case and the cases cited therein are directly in point. No one can tell what is or is not “doughnut-shaped” any more so than one can tell whether something is or is not “so shaped.” The viciousness of indefiniteness in a patent claim is the same regardless of which term is used.

The Defendants’ Design Was Independently Developed and Was a Distinct Departure From the Alleged Patented Combination.

It is true that the defendants or their predecessors once made the alleged patented seals for the plaintiffs [Finding 8, R. 39]. Subsequently, the plaintiffs and defendants came to a parting of the ways and defendants thereafter made their own seals [Finding 9, R. 39]. The seals made by the defendants, however, were not like those previously manufactured by the defendants for the plaintiffs. Nor were they like the plaintiffs’ one-piece “Lock-O-Seals” or “Stat-O-Seals.”

There were objections to the plaintiffs’ “Lock-O-Seals” manufactured under the patent in suit. In the first place, as the rubber O-ring was not attached to the metal washer it could be readily separated therefrom and become lost. Secondly, there was no assurance that the mechanic applying the seal to the bolt would have the washer frictionally positioned on the O-ring exactly halfway between the head of the bolt and the wall or faying surface as illustrated opposite page 22 of Plaintiffs’ Opening Brief. On the contrary, if the tolerances between the outside of the O-ring and the inside of the metal washer were such that the washer was loose on the O-ring, the washer would drop of its own weight against the wall and the top of the O-ring would consequently project or protrude too high above the

metal washer. Conversely, if the tolerances were such that the metal washer were tight on the O-ring, the washer as initially positioned on the bolt would be disposed against the head of the fastener and too much rubber would project or protrude below the washer prior to tightening. In either instance, and even when the O-ring exactly fit the interior of the washer there was opportunity for the washer to assume a slightly inclined or cocked position relatively to the horizontal O-ring. In other words, there was nothing to hold the washer in the centered position so beautifully illustrated opposite page 22 of Plaintiffs' Opening Brief. Defendants' witness Karres testifies to these facts at R. 696, as follows:

“Q. What were the objections to Lock-O-Seals that caused Rubber Teck to develop the Duo-Seals?
A. Principally the mechanics working applying, putting on just the washer without the rubber ring, and if they should put the rubber ring on, at times they would probably *cock the washer*. It wouldn't seal effectively. They had various trouble(s) in the field, as I understand, *of not self-centering*, and if the rubber was pushed up against the—when you place the rubber in, you would have possibly more rubber on the bottom than you would the top. *They would never self-center.*”

All of these various conditions were conducive to extrusion of the rubber and thus failing to get a perfect seal. Grass testifies, R. 710:

“The Court: And I suppose they wouldn't have been used unless they were satisfactory. Now, whether it extrudes a little or much, I don't know. I don't know as it makes a great deal of difference in this case.

The Witness: Well, your Honor, *50 per cent of them* (Lock-O-Seals made by defendants for plaintiffs) *that we made extruded*. Some of them didn't. *We couldn't manufacture that close a tolerance.*

The Court: Was any ever turned back to you because it extruded too much? A. Yes. We had them,—10 or 3/16, considerable quantities came back even after we tested them this way and measured them, and we had to change and grind down the dies, down to 66/1000 instead of 70/1000 cross section."

The defendants in bringing out their accused "Duo-Seals" attempted to remedy as many of these difficulties as possible.

(1) As the rubber was vulcanized to the metal washer, the rubber could never be separated and lost.

(2) As the rubber was vulcanized to the metal washer under all conditions of use rubber would protrude the same distance above the washer as below it—the washer could not slide up or down relatively to the rubber or be tilted sideways or cocked over.

(3) As the washer was in the mold at the time the rubber was cured and vulcanized thereto, even if the washer happened to be thick or thin within the manufacturing tolerances, the extent to which the rubber extended above the top of the metal washer and the extent to which the rubber extended below the bottom of the metal washer *was always the same* for a given size. If the metal washer was thick the top and bottom of the mold could not close together quite as close. On the other hand, if the metal washer happened to be thin the top and bottom of the mold could come together closer. In all instances including thick washers, thin washers, and washers of exact size, the distances to which the rubber pro-

jected above and below the metal washer *remained identically the same* [R. 528, 530].

The defendant's seal could, therefore, be made within close tolerances, because variations in the thickness of the metal washer did not affect the amount of rubber that projected above its top and below its bottom surfaces.

(4) Furthermore, if the inside diameter of the metal washer was large, rubber supplied to the mold merely filled the additional space in vulcanizing and bonding itself to the washer. On the other hand, if the inside diameter of the metal washer was small, less rubber was required to effect the bond with the bore of the washer [R. 530].

None of these advantages are obtainable by manufacturing the O-ring as a separate item and assembling it with a metal washer also manufactured as a separate item. When the parts are manufactured separately there is no opportunity of reconciling tolerances of one part with the tolerances of the other.

It cannot be said, therefore, that the defendants in the design and construction of their seal did not independently design their seal. A great deal of thought and design went into the defendants' seal to overcome the disadvantages in the plaintiffs' seal and to make a truly competitive product. About all that is in common between the plaintiffs' seal and the defendants' seal is that in both there is an outer metal ring, an inner rubber ring thicker than the outer metal ring, and that the interior surface of the rubber ring is rounded. Beyond this there is no similarity. These similarities are the same similarities that exist between the plaintiffs' seal

and the prior art. See the patent to Seligman. While the plaintiffs' uncopyrighted data sheet published to the trade may have been copied by the defendants in their data sheet, there is no showing on the part of the plaintiffs that the dimensions in the accused Duo-Seals actually conform to the dimensions therein given. As a matter of fact, because there are no spaces between the rubber ring and the top and bottom inner corners of the metal washer to be filled by deformed rubber, the dimensions of the rubber in the accused seal were necessarily different from those of the plaintiffs' seal embodying the standard O-ring.

Defendants' witness, Grass, testified as follows [R. 521]:

"Q. Weren't you personally the developer of the Duo-Seals? A. Yes.

Q. Well, he (Engineer Aldridge) would get the dimensions from you then, wouldn't he? A. A lot of these dimensions we got from customers. They asked for a certain size, and then we put it on our data sheet. They specified the size of washer, the size of bolt they wanted."

[R. 523]:

"Q. Did you do the computations on the rubber part? A. There was no computation. It was trial and error."

[R. 526]:

"Q. Are washers for Duo-Seals exactly the same size as washers for Lock-O-Seals? A. No, sir."

[R. 530]:

"A. I can't use those dimensions (the Lock-O-Seal dimensions) on Duo-Seals. We don't need the I. D. of the ring, we don't need the thickness of the ring."

Plaintiffs, in their brief, go into a long dissertation at pages 40 to 48 as to the activities of the plaintiffs and the defendants independently and in concert with each other, including a discussion as to who was the originator of a one-piece Lock-O-Seal known as a Stat-O-Seal. This one-piece Lock-O-Seal, as made by the plaintiffs, did not have the rubber bonded to the metal, and consequently, was subject to the same objections of rubber tolerances of the rubber rings, misfitting with respect to the metal rings. The plaintiffs contend that they are the originators of the one-piece seal. However, defendants' witness, Otto Grass, testified at R. 544 and 545 as follows:

"A. I went over to see about if we could produce as many of these Lock-O-Seals as they had orders for. They thought we weren't able to produce them, so I went over to tell them we could make 300 cavity molds instead of 200 on our regular Lock-O-Seal.

At the same time I showed him (Paul Smith, General Manager of plaintiffs, Franklin C. Wolfe Company, Inc.) this one-piece, and his exact words were, 'Why make liars out of us? We are advertising a two-piece superior to a one.'

Q. What was that one-piece you showed him made like? A. Made similar to the one we are making today.

* * * * *

Q. Was it made in the same way you make your present Duo-Seals? A. As near as I remember, as near as is possible to make it the same, yes."

Defendants' witness, Elem, testified [R. 664]:

"Q. Prior to this discussion that resulted in your making that memorandum, had you ever seen a one-piece Lock-O-Seal or similar sealing device? A. Yes.

Q. (By Mr. Miller): What kind of a device was it that you saw? A. Well, it was a rubber bonded to metal device.

Q. Are you familiar with the Duo-Seal that are put on the market today? A. Yes.

Q. How do they compare with the Duo-Seals? A. Well, configuration-wise, similar.

Q. And where did you see that? A. First I saw it at Paul Smith's office.

Q. And who had it? A. Joe Kerley.

Q. Were you a participant of the conversation between Mr. Smith and Joe Kerley? A. I was at the office.

Q. Approximately when did that occur? A. The early part of the year, I judge January, February.

Q. Of 1952? A. Right.

Q. Do you recall any of the conversation that went on between Mr. Kerley and Mr. Paul Smith? A. Mr. Kerley submitted it as a possible solution to the two-piece problem and Mr. Smith said *it was no good, it wouldn't work.*"

The plaintiffs called defendant Paul A. Karres as a witness apparently not under Rule 43(b) [R. 488]. Paul Karres testified as follows [R. 515]:

"Q. (By Mr. Fulwider): Prior to the time you offered the Duo-Seal to the trade, did you ever show a one-piece fastener seal to Mr. Gross? A. Yes, sir.

Q. Did you do that personally? A. Mr. Kerley and myself.

Q. Yes, and when was that? A. That was in the last part of '48. If I may elaborate on that answer and explain it, may I, your Honor?

Mr. Fulwider: Yes. A. This was brought to our attention by Douglas Aircraft. They had a seal-

ing problem. They brought a one-piece seal in— rather, they brought the washer in and told us to vulcanize or mold rubber to this one-piece seal.

Q. That was Douglas? A. That was an engineer of Douglas Aircraft and as I recall his name, it was Mr. Woods. They were having problems. They refused to use them at that time. Why, I don't know.

Q. Was this in 1948? A. In 1948, shortly after I was with the company.

Q. What did you do? A. We immediately made up one and took it down to Mr. Gross and that is the conversation when I first met Mr. Gross, and he said, 'It absolutely will not work,' and to forget about it."

Karres also testified that a one-piece seal was submitted to Mr. Smith, General Manager of plaintiff, The Franklin C. Wolfe Company, Inc. [R. 508]:

"Q. What did you tell him yourself? Did you tell Mr. Smith anything about this one-piece seal? A. All my conversation was very little. I just said, 'Here is a one-piece seal and I think it is much better, for your evaluation,' is the way I put it.

* * * * *

Q. What did Smith say? A. Just shook his head. He says, 'No good.'

Q. Negatively, I take it? A. 'Not worth it.'

Q. He said the seal wasn't worth what? A. Well, his words, if I remember correctly, are to the effect that, 'We have been advertising a two-piece Lock-O-Seal. Why should we call ourselves liars now and advertise a one-piece Lock-O-Seal and sell it?' "

There Was No Misuse of Alleged Trade Secrets.

From the outset of this case, the defendants have diligently sought to ascertain by discovery proceedings the basis for the allegations made in paragraphs 18, 19, 20, and 21 of the complaint appearing at R. 8 to 11, inclusive. This is the basis of finding 19 at R. 42.

During the trial the court asked Paul Smith, the general manager of plaintiff, Franklin C. Wolfe Company, Inc., as follows [R. 638]:

“The Court: You testified here that you were the general manager.

The Witness: Correct.

The Court: Of the Wolfe Company, and you brought this case here claiming there was some trade secrets taken. What were the trade secrets? You are the general manager. You ought to know.

The Witness: I believe he narrowed his question.

The Court: I am asking you.

The Witness: Broadly?

The Court: What trade secrets do you say have been taken by the defendants?

The Witness: Going to the first, I would say that they had knowledge of all our customers.

The Court: I am talking about the seal itself now. In the two seals that are manufactured, one manufactured by the defendants and one manufactured by the plaintiffs, what trade secrets do you say that the defendants in the manufacture of their seal took from the plaintiff?

The Witness: Trade secret? I am afraid I can't answer, because I don't know actually what a trade secret is in the law.

The Court: If you can't answer, that is all that is necessary.

Mr. Fulwider: I think, perhaps, would your Honor assist the witness—

The Court: Just a minute. I asked what the trade secret was. Mr. Miller has been hollering ever since this case was filed about what the trade secrets are. You get the general manager on the stand at the time of trial and he says, 'I don't know what a trade secret is.'

Mr. Fulwider: Knowing the witness as I do, I know that he is being very meticulous in his answer.

The Court: I have put the question here. Mr. Miller didn't put the question. I put the question and it wasn't a trick question either."

The conclusion is that there were no trade secrets of plaintiffs that were appropriated or misused by defendants [finding 20, R. 42] and plaintiffs, even in their brief before this court, are unable to point to any "formula, pattern, device or compilation of information" (Pltf. Br. p. 47) which the defendants are using in the manufacture or sale of the accused "Duo-Seals." Plaintiffs' uncopyrighted data sheet was published and public property and although copied as a data sheet, the dimensions thereof are not found in the defendants' "Duo-Seal" itself because of the difference in its structure and the method of its manufacture.

The lower court was well supported by substantial evidence in finding 20, R. 42: "No trade secrets of plaintiffs have been appropriated or misused by defendants."

There Is No Unfair Competition in Defendants' Use of the Trademark "Duo-Seal."

The plaintiffs finally complain about the defendants' use of the trademark "Duo-Seal." Defendants' witness Grass testifies how this term was decided upon as follows [R. 528]:

“Q. Do I understand, Mr. Grass, you were responsible for the selection of the name, 'Duo-Seal'?

A. No, I wasn't. Some of our employees were.

Q. How was it selected? A. I asked a number of people in the plant as to the name, what they would call this one-piece seal, and the majority came up with the name Duo-Seal, so I figured if the majority in the plant would come up with it, it would be a good name for the public.

Q. Did you show them 'Lock-O-Seal' or anything like that? A. I showed them the one-piece seal, yes.

Q. Were they familiar with the Wolfe Company name? A. Some of them. Some of them never heard of the Wolfe Company.

Q. Some of them never heard of the Wolfe Company? A. Never heard of them.

Q. As I understand it, you went to each one of them and asked them what they thought out for it and each one of them came up with the name 'Duo-Seal'? A. Not each one. The majority, I said.

Q. How many was the majority? A. I don't know off hand; I would say approximately five out of seven, somewhere on that order, but I testified here before in my deposition to that amount. I don't remember the exact number.

Q. But it is correct that each one of these persons was just shown this piece and he sprung up with the name 'Duo-Seal'? A. Not each one. The majority.

Q. Five out of seven? A. Yes.”

He is corroborated by Karres [R. 505].

It is obvious that the devices are *seals*. The inclusion of this term in the defendants' trademark is to merely inform the trade and public what kind of devices they really are. Being a generic or descriptive term, anyone, including these defendants, manufacturing and selling a seal is entitled to call them such.

Except for the similarity in the use of the descriptive term "seal" all further resemblance between the marks of the plaintiffs and that of the defendants ceases. Thus "Duo" is not similar to "Lock-O," "Stat-O," "Riv-O," "Termin-O," "Bolt-O," "Valv-O" or "Gask-O."

The cases cited by the plaintiffs are not in point. In *Brooks v. Great A. & P. Tea Co.*, 92 F. 2d 794, relied upon by plaintiffs at page 49 of plaintiffs' brief neither "8" nor "Bells" nor "O'Clock" were descriptive of or generic to the product coffee. In *Stamford v. Thatcher*, 200 Fed. 324, the term "mate"—the only symbol in common between the two names—was certainly not a generic or descriptive term for ship stoves.

Even in *Q-Tips, Inc. v. Johnson & Johnson*, 201 F. 2d 144, which plaintiffs agree is "a full and well reasoned decision" (Pltf. Br. p. 51) the court carefully points out:

" 'Tips,' obviously, is a regular dictionary word. It means 'the pointed or rounded end or extremity of anything.' The wood sticks, which with their cotton ends made 'Q-Tips,' are rounded by the machine-applied cotton at each end. *But this is a fanciful use of the term.* The standard medical and surgical dressing talk for gadgets of this kind would be a 'swab,' which is a 'bit of sponge, cloth, absorbent cotton, or the like, for applying medicaments to a sick person or animal, or for removing tenacious discharges from the mucous membranes * * *'; or

‘applicator,’ which is ‘a device for applying medicine to the nose, throat or other cavity * * *.’ *When Johnson and Johnson called their sticks with cotton wrapped around the end ‘Cotton-Tipped Applicators’ they were using a term as descriptive as that of ‘ten-penny nail.’*”

An influential factor in the *Q-Tips* case was that the defendant had originally marked its product “Cotton-Tipped Applicators.”

“These were sold to hospitals and physicians’ offices. The term was descriptive and non-appealing. They could also be called swabs, but the definition of that term already quoted shows the unesthetic connotation that goes with the use of the term. So the defendant submitted the matter to its advertising agency, a large, experienced and well established concern. The evidence shows a list of dozens of names suggested by various employees, many of which are arbitrary, fanciful and completely unlike anything suggested by the plaintiff’s product. But in the end defendant’s top management came up with the name under discussion, ‘Cotton Tips.’

* * * * *

“It changed the description of what it had formerly called ‘Cotton-Tipped applicators’ in all its trade literature, price lists, and so on, to ‘Cotton Tips’ and embarked on a campaign to persuade its employees that the name of the product was ‘Cotton Tips.’ We do not think it succeeded, and neither did the district court.”

In the body of the opinion the following is stated which we believe to be the proper principle applicable to the facts of this case:

“But as already indicated, the authorities do not always speak in the same tones when applying un-

disputed law to varying states of fact. See, for instance: *Thomas Kerfoot & Co. v. Louis K. Liggett Co.*, 67 F. 2d 214 (C. A. 1, 1933) ('Vapex' for an inhalant not infringed by 'Vapure' because 'Vap-' descriptive and '-ex' is dissimilar from '-ure'); *James Heddon's Sons v. Millsite Steel & Wire Works*, 128 F. 2d 6 (C. A. 6, 1942), cert. den. 317 U. S. 674 ('Head-On Basser' for fish bait not infringed by 'Millsite Bassor' because the similar part, 'basser,' is descriptive); *Pepsi-Cola Co. v. Krause Bottling Co.*, 92 F. 2d 272 (C. A. 4, 1937) ('Pepsi-Cola' not infringed by 'Pep-Ola' because 'Pep' is descriptive and the two are not confusingly similar)."

The fundamental distinction between the present case and the *Q-Tips* case is that "tips" was not the generic or descriptive term of the swabs or applicators sold under that name. In the present case the word "seal" is the generic or descriptive term describing the products of both parties to this litigation. Furthermore, beginning at R. 969, there are a number of registrations both prior to and subsequent to the date of first use claimed by the plaintiffs of their trademarks employing the term "O-Seal." Specifically Chicago Belting Co. has used, registered and republished its trademark "Aero-Seal" [R. 984] as applied to synthetic rubber packing. Electric Steel Foundry of Portland, Oregon, has used and registered the name "Duoseal" for plastic metallic gaskets for valves. The Frick Company at R. 986, has registered the term "Frick Flexo-Seal" as applied to shaft seals. The B. F. Goodrich Company has used and registered [R. 989] the term "Koroseal" as applied to extruded sealing strips, sheet packing, molded gaskets, and resilient artificial sponge sealing strips. The Viscoseal Corporation, at R. 991, has registered the name "Visco-seal" as applied to a mechanical seal for rotating shafts.

In connection with the "Aero-Seal" registration [R. 984] the word "seal" was disclaimed apart from the mark as shown and the same is true of the Frick Flexo-Seal registration [R. 986]. A similar disclaimer should have been required of the word "seal" in all of the plaintiffs' registrations but seems to have only been required and entered in the case of the "Termin-O-Seal" registration [R. 965] and the "Gask-O-Seal" registration [R. 966].

Furthermore, attention is invited to the fact that the registration "Lock O Seal" was not registered on the Principal Register but only on the Supplemental Register [R. 962]. Such being the case, proof of secondary meaning would be required to establish trademark infringement. *Armstrong v. NuEnamel*, 305 U. S. 315, 39 U. S. P. Q. 402.

The plaintiffs take the position that proof of actual confusion is unnecessary and point to a single instance of error in Exhibit 79 [R. 898]. However, the plaintiffs ignore the fact that the majority of the plaintiffs' and defendants' seals are ordered by engineers of aircraft corporations who are meticulous in their designs, and who are meticulous in ordering parts for the airplanes they are manufacturing. As stated on Exhibit 79:

"Test reports and/or certificates of conformity thereof are required on this order in accordance with Specific Condition 8C."

Certainly, when such test reports are required on the specific item ordered there is no reasonable opportunity for confusion.

We believe that the situation here should be analyzed in the same way as a comparable situation was analyzed by the Court of Customs and Patent Appeals in *Miles Laboratories, Inc. v. The Pepsodent Company*, 104 F.

2d 205, 41 U. S. P. Q. 738, 740. In that case the trademarks involved were “Pepso-Seltzer” and “Alka-Seltzer.” The Court said:

“It is clear to us that anyone has the right to use the disclaimed word ‘Seltzer’ in a descriptive way, if descriptive of his merchandise, and appellant may not rely upon the word ‘Seltzer’ in its mark as indicating origin of its goods; and, when used in combination with the word ‘Alka’ the latter would be considered by purchasers as the dominant portion of the mark indicating origin.

“To hold otherwise would result in appellant having practically a monopoly of the word ‘Seltzer’ in a trade mark.” (Emphasis added.)

Likewise here, anyone including these defendants, has the right to use the word “seal” in a descriptive way if descriptive of his merchandise, and this word cannot be relied upon as indicating origin. To hold otherwise would result in the plaintiffs having practically a monopoly of the descriptive word “Seal” which they have apparently attempted to do by registering a group of trademarks, all of which terminate in the same descriptive word. The above case was cited with approval in and similar cases were collected in *Franco-Italian Packing Corp. v. Van Camp Seafood Co., Inc.*, 142 F. 2d 274, 61 U. S. P. Q. 369.

The lower court was correct in its conclusion of law 10 [R. 46].

Practice Re Record on Appeal.

In this case the plaintiffs-appellants filed in this court a designation of record on appeal. This designation designated but a fraction of the testimony and proceedings during the trial and seems to have been designed to in-

clude only that testimony regarded as being favorable to appellants and to omit all testimony unfavorable to appellants or favorable to appellees.

Without going into too much detail, we itemize below some of the testimony appellants proposed omitting from the printed record:

(1) All cross-examination of plaintiffs' witness, Hagmann, the redirect examination and recross-examination now appearing at pages 83 to 93 of the printed record.

(2) All cross-examination of plaintiffs' witness McClay, now appearing at pages 106 to 122 of the printed record.

(3) All cross-examination of plaintiffs' expert Comstock, his redirect examination and recross-examination now appearing at pages 131 to 196 of the printed record.

(4) All cross-examination, redirect examination and recross-examination of defendant Kerley called as a witness by plaintiffs under Rule 43(b) now appearing at pages 373 to 409 of the printed record.

(5) All cross-examination of plaintiffs' witness Gross, his redirect examination and his recross-examination now appearing at pages 410 to 487 of the printed record.

(6) The direct testimony of defendant Karres called as a witness by the plaintiffs—apparently *not* under Rule 43(b) [R. 488] and which now appears at pages 515 to 517 of the printed record.

(7) Some direct testimony and all of the cross-examination of defendant, Otto Grass, called as a

witness by the plaintiffs under Rule 43(b) and now appearing at pages 537 to 559 of the printed record.

(8) All cross-examination of the plaintiffs' witness Wolfe, now appearing at pages 568 to 574 of the printed record.

(9) Some direct testimony and the entire cross-examination of Haggmann now appearing at pages 648 to 653 of the printed record.

(10) The entire testimony including direct examination and cross-examination of defendants' witness Elem, now appearing at pages 663 to 695 of the printed record apparently because plaintiffs' counsel had expressed himself as being of the opinion that he was "not telling the truth" [R. 681].

(11) The direct testimony of defendant Karres called as a defense witness, now appearing at pages 695 to 700 of the printed record.

(12) Most, but not all of the testimony of defendant, Otto Grass, now appearing at pages 706 to 721 of the printed record.

The foregoing does not purport to be a complete list of all testimony plaintiffs-appellants proposed deleting from the printed record but it should serve to illustrate that plaintiffs-appellants proposed presenting before this court a very one-sided record—one most favorable to them.

A casual inspection of the breadth of the statement of points on appeal [R. 820] indicates that plaintiffs-appellants proposed bringing before this court practically every possible issue that the case contained but only on a partial record.

It has been held that the question of whether findings of fact are clearly erroneous cannot be raised and considered on a partial record.

In the Matter of Gogate, 126 F. 2d 1020 (C. A. 3);
Sublette v. Servel, Inc., 124 F. 2d 516 (C. A. 8).

However, one panel of judges of this court has said in *Associated Indemnity Corporation v. Manning*, 107 F. 2d 362:

“Appellees while defending the findings insist that the evidence is not all here, hence the findings are not subject to attack. With respect to the latter proposition it need only be said that appellant complied with Rule 75 of the Rules of Civil Procedure * * *.”

Another panel of judges of this court has said in *Watson v. Button*, 235 F. 2d 235, 23 Fed. Rul. Serv. 75d.2, case 1:

“Appellant’s counterclaim is based ‘in reliance on the fraudulent representations of * * * (appellant) * * * upon which * * * (appellees) * * * had a right to rely.’ However, appellant has had included in the record before this court but one page of the reporter’s transcript of testimony. The burden is on him to show that the trial court’s finding was clearly erroneous. *An appellant must include in the record all of the evidence on which the District Court might have based its findings. When this is not done the judgment of the District Court must be affirmed.*”

Still another panel of judges of this court in *Bullen v. De Bretteville*, 23 Fed. Rul. Serv. 15b.1, case 3, said:

“Appellees’ Brief declares that appellants omitted significant portions of the trial record in designating the record on appeal. The charge is a serious one. But if appellees felt aggrieved, they should

have filed a petition under Rule 75(b) of the Federal Rules of Civil Procedure to have a supplemental record brought before this court. They did not do so. Their failure to follow the prescribed procedure precludes them from questioning the composition of the record. For purposes of this appeal, it must be assumed that the record accurately relates the events that transpired in the court below.”

Confronted with the uncertainty as to what to do under the circumstances created by the apparent conflict between Rule 75 and Rule 17(6) of this court pertaining to the holding of consent, defendants-appellees filed in this court a “Defendants-Appellees and Cross-Appellants Designation of Record on Appeal” pursuant to the provisions of Rule 17(6) of this court. Following this, plaintiffs-appellants filed in this court “Appellants’ Additional Designation of Record on Appeal.”

For the amount of the record designated by the defendants-appellees they were billed by the Clerk for \$1245 estimated expenses of printing that portion of the record designated by them. This was later reduced \$500 on re-estimating. The amount of \$745 has been advanced by defendants-appellees accordingly.

The plaintiffs’ ability to appeal is statutory and is consequently a matter of right, subject to the compliance with certain conditions such as

- (1) Filing a timely notice of appeal;
- (2) Posting an appropriate appeal bond; here only \$250; and
- (3) Filing a statement of points on appeal, etc.

We do not think, however, that it is proper for an appellant who appeals and files a statement of points of the breadth of those filed herein to then designate only

that portion of the record which he regards as favorable to him, making it incumbent upon the appellee to file a designation to include the omitted record *and pay for its printing* or else

“*be held to have consented* to a hearing on the parts designated.” (Rule 17(6).)

Plaintiffs had a full “day in court” and the impartial trial court has ruled against them. There is a presumption that the trial court’s decision is correct, at least as to the findings made by him. For the privilege of having this court review the case for the benefit of the plaintiffs, plaintiffs should be required to present to this court a proper record and advance the total cost of its printing. It is no answer to say that even though appellees have advanced the costs of printing that portion of the record designated by them, they will be properly taken care of in the final judgment if the decision is affirmed. A judgment may be worthless, depending upon the solvency of the plaintiffs at the time the judgment is rendered and may become unenforceable. We do not think that an appellee should be required to advance and tie up any such sum as was required by these defendants for the privilege of assuring themselves that the case will be fairly heard by this court on all of the pertinent evidence produced before the court below after the lower court has already decided the case in their favor.

In *T. V. T. Corp. v. Basiliko*, 25 Fed. Rul. Serv. 75a.3, case 1, the Court of Appeals for the District of Columbia quoted from *In re Chapman Coal Co.*, 196 F. 2d 779 at 785, as follows:

“All possible presumptions are indulged to sustain the action of the trial court. It is, therefore, elementary that an appellant seeking reversal of an order entered by the trial court must furnish to the

appellate court a sufficient record to positively show the alleged error.”

and thereafter said:

“It is the duty of the appellants to *designate* and file a record sufficient to enable us to pass on the errors of law they claim were committed below.” (Emphasis added.)

A rightful defendant may exhaust himself financially to present his defense in the trial court. A disgruntled plaintiff who designates but a fraction of the record, as was done in this case, can throw the burden on such defendant of advancing the cost of a substantial portion of the printing of the record for the sole privilege of securing a fair review before this court. A clarification of the duties of an appellant with respect to designating the record and of the proper procedure of an appellee, when the appellant fails to do so, is respectfully urged.

Conclusion.

The trial court who saw and heard the witnesses and who observed courtroom demonstrations, has made findings of fact which should not be overturned unless clearly erroneous.

The finding that there was no invention in the structure defined by claim 1 [Finding 16, R. 41] is not clearly erroneous but is well supported by competent evidence. This structure, at best, as defined by the claim, even if the words “doughnut shaped” are given their narrowest interpretation, is nothing more than a colorable departure from the prior art as represented by the Killner patent, the Seligman patent, and the structures disclosed in the Hart patents.

The finding [Finding 14, R. 40] that defendants’ rubber ring is not a “doughnut-shaped” ring is also not clearly

erroneous. Either the term is broad enough to be anticipated by the prior patents above referred to, or it must be restricted to a rubber ring that is truly circular in cross-section and not otherwise. If restricted, the defendants do not use that form and there is consequently good support for conclusion of law 3 [R. 45].

Never—from the beginning of this case—have plaintiffs identified any trade secret that has been appropriated or misused by the defendants although implored to do so. Either there was no secret or if there were, it was not used by the defendants. There is ample support for finding 20 [R. 42].

Defendants' use of the term "Duo-Seal" was not done in an effort to palm off defendants' goods as those of the plaintiffs. It was done in an effort to distinguish defendants' goods from those of the plaintiffs' and at the same time inform the trade and public that defendants' goods were seals. Conclusions of law 8, 9 and 10 [R. 46] are therefore well founded in both fact and law.

We regard this appeal by the plaintiffs not only as frivolous but merely a means of harassing the defendants. We think that that portion of the judgment from which the plaintiffs have appealed should not only be affirmed, but that attorney's fees should be awarded the defendants, taking into consideration particularly the manner in which plaintiffs proposed presenting their appeal on only a partial record.

Respectfully submitted,

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